APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/708,913	11/07/2000	J. P. Leon	00696-02500US	2660

			EXAMINER
20350	7590	10/06/2005	COSIMANO, EDWARD R

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ART UNIT	PAPER NUMBER
3639	

DATE MAILED: 10/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	09/708,913	LEON, J. P.
	Examiner	Art Unit	
	Edward R. Cosimano	3639	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>04 May 2005</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1,3-10,12-31,42-45 and 48-65</u> is/are pending in the application.

    4a) Of the above claim(s) <u>none</u> is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1,3-10,12-31,42-45 and 48-65</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on <u>11/7/00 & 12/22/03</u> is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

⟨handwritten⟩ C/C

1.   The proposed drawing correction filed 22 December 2003 has been approved by the examiner.

1.1   The combined sheets of drawings containing figs. 1 & 3-8 as filed 07 November 2000 and containing fig. 2 as filed 22 December 2003 are acceptable to the examiner.

2.   The disclosure is objected to because of the following informalities:

   A) applicant must update:

   (1) the application data on page(s) 1-2 & 14,

with the current status of each of the referenced applications, e.g., --now abandoned--, or --now patent #?--, or --which is abandoned and now serial number #?--, --which is expired--, etc. In this regard note that the records of the Patent Office indicated that application 09/708,971 is now abandoned while applications numbers 09/708,185; 09/708,792; 09/708,883; & 09/708,975 are still pending.

Appropriate correction is required.

3.   The specification and drawings have not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification or drawings. Applicant should note the requirements of 37 CFR § 1.52, § 1.74, § 1.75, § 1.84(o,p(5)), § 1.121(b-f).

4.   35 U.S.C. § 101 reads as follows:

   "Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title".

4.1   Claims 1, 3-10, 12-31, 42-45 & 48-65 are rejected under 35 U.S.C. § 101 because the invention as claimed is directed to non-statutory subject matter.

4.1.1   For the purposes of the following analysis it is noted that:

   A) in regard to how claims are to be interpreted by the U.S. Patent & Trademark Office when determining whether or not the claims recite statutory subject matter the Court of Customs and Patent Appeals (CCPA) which is the predecessor of the Court of Appeals for the Federal Circuit (CAFC) set forth that "This passage has sometimes been misconstrued as a "rule" or "definition" requiring that all processes, to be patentable,

must operate physically upon substances. Such a result misapprehends the nature of the passage quoted as dictum, in its context, and the question being discussed by the author of the opinion. To deduce such a rule from the statement would be contrary to its intendment which was *not to limit* process patentability *but to point out that a process is not limited to the means used in performing it"* and again "the claims are to be given their broadest reasonable interpretation consistent with the specification during examination of a patent application ....", and again "We are not persuaded by any sound reason why, at any time before the patent is granted, an applicant should have limitations of the specification read into a claim where no express statement of the limitation is included in the claim.", In re Prater, 56 CCPA 1381, 1395-96, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-51 (1969). Where the broadest reasonable interpretation was latter further defined by the CAFC to be:

(1) different from the way claims are to be interpreted by the Court in infringement suits, In re Morris, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027-28 (Fed. Cir. 1997) (The court held that the PTO is not required, in the course of prosecution, to interpret claims in applications in the same manner as a court would interpret claims in an infringement suit. Rather, the "PTO applies to verbiage of the proposed claims the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in applicant's specification."); and

(2) limited to "The broadest reasonable interpretation of the claims must also be consistent with the interpretation that those skilled in the art would reach.", In re Cortright, 165 F.3d 1353, 1359, 49 USPQ2d 1464, 1468 (Fed. Cir. 1999)",

B) further in regard to the nature of statutory subject matter the Supreme Court in Diamond, Commissioner of Patents and Trademarks v. Diehr and Lutton, 209 USPQ 1, 9, (US SupCt, 1981) makes the following statement, "Our earlier opinions lend support to our present conclusion that a claim drawn to subject matter otherwise statutory does not

become nonstatutory simply because it uses a mathematical formula, computer program or digital computer.", from this statement it can be seen that the manner in which a process or machine may be implemented or may not be implemented is not a factor that may be used to determine if the claim as a whole recites statutory subject matter.

C) the CCPA further held that "We view the results here as being similar to those in Gelnovatch -- a simulation of something physical is produced by a process akin to mathematical modeling. Each and every step in these claims involves or intimately relates to mathematical operations; we can view the end product _in this case_ only as a mathematical result.", and again "These claims are directed to the process of cross-correlation in the abstract. They are not limited to any particular art or technology, unless pure mathematics is considered as an art or technology. The "signals" processed by the inventions of claims 10-12 may represent either physical quantities or abstract quantities; the claims do not require one or the other. The claims thus dominate the particular method of cross-correlation in any and all arts. They are classic examples of an attempt to embrace the algorithm or scientific truth itself rather than a particular application.", In re Walter, 205 USPQ 397, 409 (CCPA 1980) {emphasis added}.

4.1.2   At this point, it is noted at this point that the CAFC has held in AT & T Corp. v. Excel Communications Inc. 50 USPQ2d 1447 @ 1452 (CAFC 1999) that "[1] In both _Alappat_ and _State Street_ , the claim was for a machine that achieved certain results. In the case before us, because Excel does not own or operate the facilities over which its calls are placed, AT & T did not charge Excel with infringement of its apparatus claims, but limited its infringement charge to the specified method or process claims. Whether stated implicitly or explicitly, we consider the scope of Section 101 to be the same regardless of the form -- machine or process -- in which a particular claim is drafted. _See, e.g._ , _In re Alappat_ , 33 F.3d at 1581, 31 USPQ2d at 1589 (Rader, J., concurring) ("Judge Rich, with whom I fully concur, reads Alappat's application as claiming a machine. In fact, whether the invention is a process or a machine is irrelevant. The language of the Patent Act itself, as well as Supreme Court rulings, clarifies that Alappat's invention fits comfortably within 35 U.S.C. Section 101 whether viewed as a process or a machine."); _State Street_ , 149 F.3d at 1372, 47 USPQ2d at 1600 (" [F]or the purposes of a Section 101 analysis, it is of little relevance whether claim 1 is directed to a 'machine' or a 'process,' . . . ."). Furthermore,

the Supreme Court's decisions in *Diehr* , *Benson* , and *Flook* , all of which involved method (i.e., process) claims, have provided and supported the principles which we apply to both machine-and process-type claims. Thus, we are comfortable in applying our reasoning in *Alappat* and *State Street* to the method claims at issue in this case." {emphasis added}, hence, both process and machine claims are to be treated the same and not to be treated differently based on the how the claim is drafted.

4.1.3   The instant claims recite a system, (claims 56-65), and a process comprising a series of steps to be performed, (claims 1, 3-10, 12, 23-31, 42-45, 48-55), and a manufacture comprising program code which is not stored on a media, (claims 13-22), which have a disclosed practical application in the technological or useful arts.   Further, the instant claims do not merely define either a computer program, a data structure, non-functional descriptive material, (i.e. mere data) or a natural phenomenon.

4.1.4   In regard to claims 1, 3-10, 12, 23-31, 42-45 & 48-65, the invention as set forth in these claims merely describes:

A) in regard to:

(1) process claims 1, 3-10 & 12, a process that merely implements the functions/acts of:

(a) receiving first information from a first device at a second device;

(b) sending second information to the first device from the second device;

(c) displaying the second information at the first device and receiving at the second device input based on the displayed second information;

(d) receiving at the second device third information for printing that has been generated at a separate third device in response the received input regarding the selected second information; and

(e) received the third information at the first device from the second device; and

(2) process claims 23-31, a process that merely implements the functions/acts of:

(a) receiving first information from a first device at a second device;

(b) receiving at the second device second information for printing that has been generated at a separate third device in response the received requests from the first device; and

(c) receiving the second information at the first device from the second device; and

(3) process claims 42-45 & 48-55, a process that merely implements the functions/acts of:

(a) receiving first information from a first device at a second device;

(b) receiving at the second device second information for printing that has been generated at a separate third device in response the received requests from the first device and validating payment for the request; and

(c) receiving the second information at the first device from the second device.

Where it is noted that the phrase "for printing" is deemed to be optional language that indicates an intended use, because this language does not positively recite that the function/act of printing is performed and therefore these claims are directed to a process that transfers data and manipulates data with out achieving a concrete and tangible practical application of the claimed process.

B) in regard to claims 13-22, a article comprising program code that if the program were to be executed by a processor, then the code would merely implement the functions/acts of:

(1) receiving first information from a first device at a second device;

(2) sending second information to the first device from the second device;

(3) displaying the second information at the first device and receiving at the second device input based on the displayed second information;

(4) receiving at the second device third information for printing that has been generated at a separate third device in response the received input regarding the selected second information; and

(5) received the third information at the first device from the second device.

Where it is noted that the phrases "computer program product executing on a data processor of a client system" and "for printing" are deemed to be optional language that indicates an intended use because this language does not positively recite that the functions/acts of executing and printing are performed and therefore these claims are directed to a non functional data structure that does not achieve a concrete and tangible practical application of the claimed article.

C) in regard to machine claims 56-56, a machine that merely implements the functions/acts of:

(a) receiving first information from a first device at a second device;

(b) receiving at the second device second information for printing that has been generated at a separate third device in response the received requests from the first device; and

(c) receiving the second information at the first device from the second device; and

However, the process/machine/manufacture as recited in these claims does not require that the result of either the claim as a whole or the manipulations of data as recited in these claims be applied in any manner so as to be tangibly used in a concrete manner and hence to produce a useful concrete and tangible result, that is a concrete and tangible application with in the technological or useful arts.

4.1.5   It is further noted that applicant has not recited in these claims a specific process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, which is either:

A) altered or changed or modified by the invention recited in claims; or

B) utilizes the result of the invention recited in these claims; or

C) is operated or controlled by the result of the invention recited in these claims.

4.1.6   It is further noted in regard to claims 1, 3-10, 12-31, 42-45 & 48-65, that as claimed applicant has not claimed:

A) pre computer processing, since the claims fail to recited that the data, which originates from an unknown source, is manipulated or transformed/changed before it is processed by the claimed invention; or

B) post computer processing, since the claims fail to recited that the data which represents the result of the claimed manipulation, is either manipulated or used nor changed by any device after it has been processed by the claimed invention; or

C) an actual practical use of the claimed invention by any physical system or device or method outside of the claimed invention other than a statement of the intended use of the claimed invention; or

D) process steps or physical acts/operations by the claimed invention that would affect the internal operation of a computer/machine as were found to be statutory in either In re McIlroy 170 USPQ 31 (CCPA, 1971) or In re Waldbaum 173 USPQ 430 (CCPA, 1972); or

E) process steps or physical acts/operations by the claimed invention that would be considered as going beyond the manipulation of "abstract ideas" as were found to be non-statutory in In re Warmerdam 31 USPQ2d 1754 (CAFC, 1994); or

F) a concrete and tangible practical application of either:

(1) the invention as a whole; or

(2) the final results of the manipulations/actions with in the technological or useful arts;

note In re Sarkar 200 USPQ 132 (CCPA, 1978) where the process step of "constructing said obstruction within the actual open channel at the specified adjusted location indicated by the mathematical model" was held to be so tenuous connected to the remaining process steps as to not be a process with in the scope of 35 U.S.C. § 101.

Hence, the invention of claims 1, 3-10, 12-31, 42-45 & 48-65 is merely directed to an hypothetical mental exercise that manipulates an abstract idea of manipulating and transferring data to create other data that is not required to be physically implemented by the claimed invention and hence is with out a claimed concrete and tangible practical application of the

abstract idea, (note <u>In re Beauregard</u> 35 USPQ2d 1383 (CAFC 1995) and the associated claims of U.S. Patent 5,710,578; and <u>State Street Bank & Trust Co. v. Signature Financial Group Inc.</u> 47 USPQ2d 1596 (CAFC 1998)).

4.1.7   It is further noted that the type/nature of either the data or the calculated numbers does not affect the operation of the claimed invention and hence are considered to be non function descriptive material, (note <u>In re Gulack</u>, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983)).

4.1.8   In practical terms, claims define nonstatutory processes if they:

> A) consist solely of mathematical operations without some claimed practical application (i.e., executing a "mathematical algorithm"); or

> B) simply manipulate abstract ideas, e.g., a bid (Schrader, 22 F.3d at 293-94, 30 USPQ2d at 1458-59) or a bubble hierarchy (Warmerdam, 33 F.3d at 1360, 31 USPQ2d at 1759),

without some claimed practical application of the mathematics or abstract idea.

4.1.9   In view of the above analysis claims 1, 3-10, 12-31, 42-45 & 48-65, as a whole, are directed to an hypothetical mental exercise that merely manipulates mathematics or an abstract idea without a claimed concrete and tangible practical application of the mathematics or abstract idea, and hence are directed to non-statutory subject matter.

4.2   Claims 13-22 are rejected under 35 U.S.C. § 101 because the invention as claimed is directed to non-statutory subject matter.

4.2.1   The instant claims recite an article comprising instructions/code, (claims 13-22), which has a disclosed practical application in the technological or useful arts, and which does not merely define either a computer program, a data structure, non-functional descriptive material, (i.e. mere data) or a natural phenomenon.   Hence, the instant claims merely define device/manufacture that contains a data structure comprising series of steps or acts or functions or operations that as claimed could be but are not necessarily to be performed by a computer.

4.2.2   It is further noted that applicant has not recited a specific machine since the steps or acts or functions or operations recited in the claim are not required to be implemented by a processor/computer, the recited functions are merely to illustrate the steps or acts or functions or operations of the instant invention.   Hence, applicant envisions the invention as recited in claims

13-22 as a disembodied data base or a computer program as a non-functional data structure. Such a disembodied storage device is not a specific machine because:

A) it is not associated with a computer in such a way as to cause the computer to operate in a specific manner, (note In re Beauregard 35 USPQ2d 1383 (CAFC 1995) and the associated claims of U.S. Patent 5,710,578); and

B) a memory device alone can not perform the functions recited within the claims. Therefore, the recited disembodied data structure, which itself can not perform the functions recited within the claims as the invention, is inoperative and lacks utility for the purpose of the invention.

5.2.3   In view of the above, the invention recited in claims 13-22, merely describes an abstract idea of a disembodied data structure or a computer program as a non-functional data structure, since a disembodied data structure by itself can not produce a concrete and tangible result by performing the functions recited within the claims as the invention (State Street Bank & Trust Co. v. Signature Financial Group Inc. 47 USPQ2d 1596 (CAFC 1998)). Hence, claims 13-22 do not have a claimed practical application, since the disembodied data structure is inoperative and therefore lacks utility for the purpose of the invention.

4.2.4   Nonfunctional descriptive material cannot render nonobvious an invention that would have otherwise been obvious. Cf. In re Gulack, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) (when descriptive material is not functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability). Common situations involving nonfunctional descriptive material are:

- a computer-readable storage medium that differs from the prior art solely with respect to nonfunctional descriptive material, such as music or a literary work, encoded on the medium;

- a computer that differs from the prior art solely with respect to nonfunctional descriptive material that cannot alter how the machine functions (i.e., the descriptive material does not reconfigure the computer), or

- a process that differs from the prior art only with respect to nonfunctional descriptive material that cannot alter how the process steps are to be performed to achieve the utility of the invention.

Further:

A) as set forth in MPEP § 2106(II)(C), optional language does not positively require a function of a limitation to be performed also does not limit the claims; and

B) as set forth in MPEP § 2106(IV)(B)(1), "Descriptive material can be characterized as either "functional descriptive material" or "nonfunctional descriptive material." In this context, "functional descriptive material" consists of data structures and computer programs which impart functionality when employed as a computer component. ... "Nonfunctional descriptive material" includes but is not limited to music, literary works and a compilation or mere arrangement of data. Both types of "descriptive material" are nonstatutory when claimed as descriptive material per se. Warmerdam, 33 F.3d at 1360, 31 USPQ2d at 1759. ... When nonfunctional descriptive material is recorded on some computer-readable medium, it is not statutory since no requisite functionality is present to satisfy the practical application requirement. Merely claiming nonfunctional descriptive material stored in a computer-readable medium does not make it statutory. Such a result would exalt form over substance. ... ."; and

C) as set forth in MPEP § 2106(IV)(B)(2)(b) "(b) Nonfunctional Descriptive Material Descriptive material that cannot exhibit any functional interrelationship with the way in which computing processes are performed does not constitute a statutory process, machine, manufacture or composition of matter and should be rejected under 35 U.S.C. 101. Thus, Office personnel should consider the claimed invention as a whole to determine whether the necessary functional interrelationship is provided. Where certain types of descriptive material, such as music, literature, art, photographs and mere arrangements or compilations of facts or data, are merely stored so as to be read or outputted by a computer without creating any functional interrelationship, either as part of the stored data or as part of the computing processes performed by the computer, then such descriptive material alone does not impart functionality either to the data as so structured, or to the computer. Such "descriptive material" is not a process, machine, manufacture or composition of matter. (Data consists of facts, which become information when they are seen in context and convey meaning to people. Computers process data without any understanding of what that data represents. Computer Dictionary 210

(Microsoft Press, 2d ed. 1994).) The policy that precludes the patenting of nonfunctional descriptive material would be easily frustrated if the same descriptive material could be patented when claimed as an article of manufacture. For example, music is commonly sold to consumers in the format of a compact disc. In such cases, the known compact disc acts as nothing more than a carrier for nonfunctional descriptive material. The purely nonfunctional descriptive material cannot alone provide the practical application for the manufacture. Office personnel should be prudent in applying the foregoing guidance. Nonfunctional descriptive material may be claimed in combination with other functional descriptive multi-media material on a computer-readable medium to provide the necessary functional and structural interrelationship to satisfy the requirements of 35 U.S.C. 101. The presence of the claimed nonfunctional descriptive material is not necessarily determinative of nonstatutory subject matter. For example, a computer that recognizes a particular grouping of musical notes read from memory and upon recognizing that particular sequence, causes another defined series of notes to be played, defines a functional interrelationship among that data and the computing processes performed when utilizing that data, and as such is statutory because it implements a statutory process.".

4.2.5   Hence, claims 13-22 directed to non-statutory subject matter.

5.   In regard to the flowing rejections based on the prior art:

    A) it is respectfully noted that the function provided by hyper text is to either:

        (1) transfer the user from one point on a network to another point on the network; or

        (2) to retrieve additional information from the network;

hence, one of ordinary skill at the time the invention was made would have recognized the function of hypertext or HTTP or HTML as functionally equivalent to a function call or a request from one system to an other system.

    B) it is respectfully noted that in regard to the use of either HTML or SSL when communicating between various computers/systems:

        (1) as would be readily recognized by one of ordinary skill in the art at the time of the invention a suitable communications protocol/procedure must be used

for any two or more systems/computers to communicate with each other so that that each of the communicating systems would properly interpret any messages that are exchanged as well as the content of the exchanged messages, hence the systems of the applied prior art would inherently use such a communications protocol/procedure when exchanging information/data.

(2) since the instant claims fail to recite a limitation that includes a recitation of the particular operation/function of either HTML or SSL that would affect how the claimed method/manufacture/system would operate other than that fact that HTML and SSL are used, the references to either HTML or SSL are deemed to be nonfunctional descriptive material. Nonfunctional descriptive material cannot render nonobvious an invention that would have otherwise been obvious. Cf. In re Gulack, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) (when descriptive material is not functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability). Common situations involving nonfunctional descriptive material are:

- a computer-readable storage medium that differs from the prior art solely with respect to nonfunctional descriptive material, such as music or a literary work, encoded on the medium;

- a computer that differs from the prior art solely with respect to nonfunctional descriptive material that cannot alter how the machine functions (i.e., the descriptive material does not reconfigure the computer), or

- a process that differs from the prior art only with respect to nonfunctional descriptive material that cannot alter how the process steps are to be performed to achieve the utility of the invention.

6.   The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject

matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

(c) Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

6.1   Claims 1-10 & 12-65 are rejected under 35 U.S.C. § 103(a) as being unpatentable over either Shah et al (5,822,738) or Kara (5,822,739 or 6,249,777) as evidence by of Carroll et al (6,470,327) and further in view of an obvious relocation of parts (In re Japikse, 86 U.S.P.Q. 70 @ 73 (CCPA, 1950)) and a reordering of functions (In re Japikse, 86 U.S.P.Q. 70 @ 73 (CCPA, 1950)).

6.1.1   In regard to claims 1-3, 8-10, 12-15, 20-26, 28, 32-36, 38, 42-49, 51, 52, 54, 56-58, 60-63 & 65, it is noted that either Shah et al ('738) or Kara et al ('739 or '777) discloses a computer implemented system that under the control of an operating program/system stored in the memory of the system implements a networked based postage dispensing system in which multiple computerized systems must co-operate in order to dispense postage. To this end it is further noted that:

A) Shah et al ('738) discloses that when an user at one or more computer systems (20: fig. 6) desires to obtain postage, the user would use a suitable interface, that is displayed on system 20, to enter all of the information that would be required in order to obtain a postage indicia. Once the required information has been entered, computer system 20 would use the entered information to formulate a request for postage, that is a request for a postage indicia. After the request has been form, the request is sent over a suitable communications network using a suitable a communications link to multifunction proxy computer (120: fig. 6). Proxy computer 120, which provides a number of functions related to the operation of the system of Shah et al ('738) does not dispensing postage, merely passes the request for postage to SMD (210: fig. 6) which has

been licensed to dispense postage by an associated carrier, for example the Unites States Postal Service (USPS). SMD 120 after having received the request for postage and has validated the request for postage creates a complete postage indicia based on the received request. Next SMD 210 sends the created postage indicia back through the proxy computer 120 to the user's computer system 20. Finally the user may print the received postage indicia on an item of mail using printer (60: fig. 6).

B) either Kara et al ('739 or '777) discloses that when an user at one or more computer systems (20: fig. 1/1A) desires to obtain postage, the user would use a suitable interface, that is displayed on system 20, to enter all of the information that would be required in order to obtain a postage indicia. Once the required information has been entered, computer system 20 would use the entered information to formulate a request for postage, that is a request for a postage indicia. After the request has been form, the request is sent over a suitable communications network using a suitable a communications link to computer (10: fig. 1/1A). Computer 10 dispenses postage by merely passes the request for postage to SMD (14: fig. 1/1A) which has been licensed to dispense postage by an associated carrier, for example the Unites States Postal Service (USPS). SMD 14 after having received the request for postage and has validated the request for postage creates a complete postage indicia based on the received request. Next SMD 14 sends the created postage indicia back through the proxy computer 10 to the user's computer system 20. Finally the user may print the received postage indicia on an item of mail using printer (24: fig. 1/1A).

6.1.2   It is noted that neither Shah et al ('738) nor Kara et al ('739 or '777) disclose the exchange of information using HTML or SSL communications protocols. However in the environment of postage dispensing over networks Carroll et al ('327) discloses a computer implemented system that under the control of an operating program/system stored in the memory of the system implements a networked based postage dispensing system in which multiple computerized systems must co-operate in order to dispense postage. To this end, when an user at one or more computer systems (20: fig. 1A) desires to obtain postage, the user would use a suitable interface, that is displayed on system 20, to enter all of the information that would be required in order to obtain a postage indicia. Once the required information has been entered,

computer system 20 would use the entered information to formulate a request for postage, that is a request for a postage indicia. After the request has been form, the request is sent over a suitable communications network using a suitable a communications link to postage rating server computer (10: fig. 1A). Computer 10 uses the received request for to rate an item of mail so as to determine the correct amount of required postage. The determined amount of postage is then used to remotely set postage meter 40 to the correct postage value so that postage meter 40 may then print/apply the postage to an item of mail.

6.1.3 Since, as can be seen above all of either Shah et al ('738) or Kara et al ('739 or '777) and Carroll et al ('327) implement postage dispensing system using a number of interconnected networked computer systems that co-operate in order to dispense postage where the dispensing system of Carroll et al ('327) is an internet based client/server based postage dispensing system, it would have been obvious to one of ordinary skill at the time the invention was made that the networked based postage dispensing systems of either Shah et al ('738) or Kara et al ('739 or '777) could be modified as evidence by Carroll et al ('327) to be implemented by an user at a client computer entering postage determining data which is sent as a request for a postage indicia to a remote postage indicia generating server/computer that verifies the request and then returns a postage indicia to the client computer for printing when the request has been verified absent a showing of new and unexpected results from using a particular procedure or system, since such a modification is merely a relocation of parts and/or relocation/sequence of functions would not affect the over all operation of the systems of either Shah et al ('738) or Kara et al ('739 or '777) when dispensing postage, for as the Court has stated it is not invention to merely move the location of a device, since the new position does not affect, i.e. modify the operation of the device, (In re Japikse, 86 U.S.P.Q. 70 @ 73 (CCPA, 1950)).

6.1.4 In regard to claims 4, 16, 31 & 41, since the postage dispensing systems of either Shah et al ('738) or Kara ('739 or '777) as evidence by Carroll et al ('327) and further in view of a relocation of parts are implemented using a number of computers which require an operating program to control the operation of the system, the systems of either Shah et al ('738) or Kara ('739 or '777) as evidence by Carroll et al ('327) and further in view of a relocation of parts, it would have been obvious to one of ordinary skill at the time of the invention that the postage dispensing systems of either Shah et al ('738) or Kara ('739 or '777) as evidence by Carroll et al

('327) and further in view of a relocation of parts would inherently contain a number of software components, where each software module would perform a particular function related to accomplishing the over all proper operation of the postage dispensing systems of either Shah et al ('738) or Kara ('739 or '777) as evidence by Carroll et al ('327) and further in view of a relocation of parts.

6.1.5   In regard to claims 5, 6, 17 & 18, since the postage dispensing systems of either Shah et al ('738) or Kara ('739 or '777) as evidence by Carroll et al ('327) and further in view of a relocation of parts are implemented using a number of co-operating computers which will automatically print the postage indicia, it would have been obvious to one of ordinary skill at the time of the invention that the postage dispensing systems of either Shah et al ('738) or Kara ('739 or '777) as evidence by Carroll et al ('327) and further in view of a relocation of parts would inherently print the requested postage indicia with or without human intervention.

6.1.6   In regard to claims 7, 19, 27, 37, 53 & 59, since the postage dispensing system of either Shah et al ('738) or Kara ('739 or '777) as evidence by Carroll et al ('327) and further in view of a relocation of parts are implemented using a number of standard computer systems that use standard printers rather than a photographic reproduction process, it would have been obvious to one of ordinary skill at the time of the invention that the postage dispensing systems of either Shah et al ('738) or Kara ('739 or '777) as evidence by Carroll et al ('327) and further in view of a relocation of parts would inherently contain a bit-map of the indicia that along with standard printer control codes are used to control the standard printer, that is associated with the standard computer system, to accurately reproduce the requested postage indicia for applying/printing on an item of mail.

6.1.7   In regard to claims 9, 10, 29, 39, 50 & 55, since the postage dispensing system of either Shah et al ('738) or Kara ('739 or '777) as evidence by Carroll et al ('327) and further in view of a relocation of parts uses an indicia that is combination of fixed or background information and variable information, e.g. the date, postage, and verification data, it would have been obvious to one of ordinary skill at the time of the invention that the postage dispensing systems of either Shah et al ('738) or Kara ('739 or '777) as evidence by Carroll et al ('327) and further in view of a relocation of parts would inherently combine these two sources of information to form a complete postage indicia.

6.1.8   In regard to claims 30, 40 & 64, either Shah et al ('738) or Kara ('739 or '777) as evidence by Carroll et al ('327) and further in view of a relocation of parts does not disclose using the XML communications protocol, however, either Shah et al ('738) or Kara ('739 or '777) as evidence by Carroll et al ('327) and further in view of a relocation of parts does require the use of a communications protocol which will support the required communications between the various components of the system, therefore it would have been obvious to one of ordinary skill at the time the invention was made that the systems of either Shah et al ('738) or Kara ('739 or '777) as evidence by Carroll et al ('327) and further in view of a relocation of parts could be modified to use any suitable communications protocol that would support the communications requirements of the systems of either Shah et al ('738) or Kara ('739 or '777) as evidence by Carroll et al ('327) and further in view of a relocation of parts in order to accomplish the proper operation of the postage dispensing systems of either Shah et al ('738) or Kara ('739 or '777) as evidence by Carroll et al ('327) and further in view of a relocation of parts.

7.   Response to applicant's arguments.

7.1   All rejections and objections of the previous Office action not repeated or modified and repeated here in have been over come by applicant's last response.

7.2   As per the 35 U.S.C. § 101, since it is noted:

        A) in regard to the claimed limitations of "computer program product executing on a data processor of a client system" and "for printing" that are deemed to be optional language that indicates an intended use, see MPEP § 2106(II)(C), these phrases do not limit the claimed subject matter and hence can not be used to distinguish the claimed subject matter; and

        B) in regard to the claimed limitation of sending the indicia information from one location to another location, as set forth in MPEP § 2106(IV)(B)(2)(b)(i), "step of "transmitting electrical signals representing" the result of calculations (In re De Castelet, 562 F.2d 1236, 1244, 195 USPQ 439, 446 (CCPA 1977) ("That the computer is instructed to transmit electrical signals, representing the results of its calculations, does not constitute the type of post solution activity' found in Flook, [437 U.S. 584, 198 USPQ 193 (1978)], and does not transform the claim into one for a process merely using an algorithm. The final transmitting step constitutes nothing more than reading out the

result of the calculations.")" and in MPEP § 2106(IV)(B)(2)(b)(ii), "A claim is limited to a practical application when the method, as claimed, produces a concrete, tangible and useful result; i.e., the method recites a step or act of producing something that is concrete, tangible and useful. See AT &T, 172 F.3d at 1358, 50 USPQ2d at 1452. Likewise, a machine claim is statutory when the machine, as claimed, produces a concrete, tangible and useful result (as in State Street, 149 F.3d at 1373, 47 USPQ2d at 1601) and/or when a specific machine is being claimed (as in Alappat, 33 F.3d at 1544, 31 USPQ2d at 1557 (in banc)."; and

        C) in regard to the claimed program code of claims 13-22, as set forth in MPEP § 2106(IV)(B)(1), "When nonfunctional descriptive material is recorded on some computer-readable medium, it is not statutory since no requisite functionality is present to satisfy the practical application requirement. Merely claiming nonfunctional descriptive material stored in a computer-readable medium does not make it statutory. Such a result would exalt form over substance.", and in MPEP § 2106(IV)(B)(1)(a), "Similarly, computer programs claimed as computer listings per se, i.e., the descriptions or expressions of the programs, are not physical "things." They are neither computer components nor statutory processes, as they are not "acts" being performed. Such claimed computer programs do not define any structural and functional interrelationships between the computer program and other claimed elements of a computer which permit the computer program's functionality to be realized.";

Applicant's arguments and or proposed amendments are deem to be non persuasive.

7.3   As per the 35 U.S.C. § 103 rejection, in view of the above modified rejection merely calling an item something with out attributing specific functions to the claimed feature that would clearly distinguish the claimed feature from any other device that would be recognized as performing the same function does not provide functional descriptive material on which a patentable distinction may be based. Nonfunctional descriptive material cannot render nonobvious an invention that would have otherwise been obvious. Cf. In re Gulack, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) (when descriptive material is not functionally related to the substrate, the descriptive material will not distinguish the invention from the prior

art in terms of patentability). Common situations involving nonfunctional descriptive material are:

> - a computer that differs from the prior art solely with respect to nonfunctional descriptive material that cannot alter how the machine functions (i.e., the descriptive material does not reconfigure the computer), or

> - a process that differs from the prior art only with respect to nonfunctional descriptive material that cannot alter how the process steps are to be performed to achieve the utility of the invention.

Hence, applicant's arguments are non persuasive.

8.   The shorten statutory period of response is set to expire 3 (three) months from the mailing date of this Office action.

9.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edward Cosimano whose telephone number is (571) 272-6802. The examiner can normally be reached Monday through Thursday from 7:30am to 6:00pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss, can be reached on (571) 272-6812. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (571) 272-3600.

9.1   The fax phone number for **UNOFFICIAL/DRAFT FAXES** is (571) 273-6802.

9.2   The fax phone number for **OFFICIAL FAXES** is (571) 273-8300.

9.3   The fax phone number for **AFTER FINAL FAXES** is (571) 273-8300.

09/26/05

Edward R. Cosimano
Primary Examiner Unit 3639